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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,897	12/09/2003	Andrew M.K. Pennell	019934-003720US	6930
20350 7590 01/29/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER BERNHARDT, EMILY B	
			ART UNIT	PAPER NUMBER
			1624	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/732,897

Applicant(s)

PENNEL ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 10, 11, 18-50 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 10, 11, 18-50 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

In view of applicants' response filed 11/6/06 the following still applies.

The specification remains objected to for reason given previously. No amendment to parent history is seen in the file.

Claims 1-4,6,7,10,11,18-50 and 53 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Reason #2 of the previous action remains. Applicants in response to this rejection urge that other rings such as piperidine, piperazine and pyrrolidine are intended in addition to morpholine which is described. But there are other possibilities which could be covered by the claim language such as other hetero atoms as ring members- S,Si,P- to name a few as well as hetero atoms bonded to each other. Thus such limitations cannot be read into the claims which is open to other possibilities not particularly enabled as set forth in the below rejection under par.one. Note In re Priest 199 USPQ 11. Note also Ex parte Oetiker 23 USPQ 2d 1651 at 1658. It is noted that piperazine, piperidine have been exemplified in the Figures so that amending the definition of NRcRd and NRfRg wherever they appear to

read "... to form a five or six-membered saturated ring having from 0-1 additional heteroatoms selected from N and O" would clarify intended scope.

2. Several of the provisos at the end of claim 1 are extraneous in view if deletion of nonelected subject matter. Note the imidazole species. Also the last species while directed to a pyrazole also appears to be extraneous since the substituent on the isoxazole (directly attached to the phenyl as Ar¹) is not seen to be covered by claims' scope. Note the choices for optional substituents for R^e does **not** include and aminomethyl link.

Claims 1-4,6,7,10,11,18-50 and 53 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of the previous action is repeated. While applicants have fixed the point of attachment of HAr to the N atom and narrowed the scope of R1 and L1 in main claim 1, scope of substituents permitted in the Ar1 and HAr rings is still enormous compared to what has been made and tested. Contrary to what applicants state, it is not seen that amended

claims represent the scope of claim 17. At the very least Ar1 can still be substituted with up to 5 substituents which include many differing types of rings as substituents within the various R variables and for HAr the same applies for R and Y variables compared to the list depicted in Figures 2A-2F and 3.

The art rejections of the previous action have been overcome by applicants' amendments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4,6 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beavers. Beavers found in an updated search has at least an effective filing date of 8/10/01 which is much earlier than applicants' effective filing date. It describes very similar pyrazole compounds for uses mediated by cathepsin S inhibitors. Closest compound is eg.7 which differs only in link connecting the piperazine and pyrazole rings. The species exemplifies a 2-OH propylene link vs. instant propanoyl when L1= C2 alkylene. Note that Beavers expressly includes oxo as a substituent on the alkylenes. See definition of "G" on page 2, right column, section [0038]. Thus it would have been obvious to one skilled in the art at

the time the instant invention was made to modify the link in eg.7 by replacing OH with oxo at any one of the 3 carbon chain and in so doing obtain an instant compound for the uses described by the art in view of the equivalency teaching outlined above.

Claims 1-4,6,7,10,11,18-50 and 53 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,157,464, which has recently issued for reasons given in previous action. Applicants' intent to file a terminal disclaimer has been noted.

Applicants' IDS filed 7/17/06 has been considered and a signed copy accompanies this action. The list of copending applications on the cover page of the IDS have been considered. They mainly consist of refiled cases of parent which have not yet been examined and a case (11/071880) drawn to different cores.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

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If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Emily Bernhardt
Primary Examiner
Art Unit 1624